

## **REMARKS**

Claims 1-7, 10, 11 and 13-22 are now rejected under 35 USC 102(e) as being anticipated by Forslow (US 2003/0039237 A1, newly cited). Claims 25 and 27-33 are again rejected under 35 USC 103(a) as being unpatentable over Leung (US 6,501,746) in view of Joong (US 6,549,776). These rejections are respectfully disagreed with and are traversed below.

Forslow discloses the use of a common access server 118 at a GGSN 116 (e.g., paragraph [0078]). In a common authentication procedure (FIG. 12), if a PDP context has been requested by the mobile station, created, and accepted by the GGSN, the mobile station also starts the common dynamic host configuration procedure (interleaved with the common authentication procedure) to establish a logical relationship to the GGSN by sending a DHCP Discover message providing the mobile station's unique identifier (MSid), a user identifier (Userid), a password, and other parameters that may be used to identify and authenticate the mobile station (paragraph [0097]).

The GGSN stores the mobile station's MSid (based on the IMSI), Userid, and password and proceeds with a common host configuration procedure. At this point a common authentication procedure with an ISP is completed for both circuit-switched and packet-switched bearer services (paragraph [0098]).

If a new application flow is started by the mobile station, rather than performing another authentication procedure involving the external ISP, the MSid, Userid, and password received in a PAP/CHAP request from the mobile station are compared to values stored in the common access server during the initial authentication procedure. If the received values match those stored in the access server, an authentication confirmation is transmitted as a CHAP/PAP response through the direct access unit at the MSC to the mobile station. The common access server matches the provided information with the stored information and authenticates the mobile without having to undertake another authentication procedure with the radius server in the ISP. This same type of abbreviated authentication procedure is performed for other, subsequent application flows commenced during the session. (Paragraph [0100]).

The Examiner appears to be equating the common access server 118 of the GGSN 116 with the claimed subscriber database. While the Examiner's interpretation is not agreed with, the Examiner continues by equating the claimed "performing automated checking of a right of the terminal to use said subscriber database" with the disclosure in paragraphs [0100] and [0101].

These paragraphs do not disclose the claimed subject matter. Even if one were to equate the claimed "subscriber database" with the mobile station information (MSid, Userid and password) stored by the GGSN in the common access server 118, which is not admitted is the case, there is no disclosure of "performing automated checking of a right of the terminal to use said subscriber database". Instead, what is disclosed (in paragraphs [0099] and [0100]) in part is simply that if one assumes that:

...a new application flow is started at the mobile station (e.g., an audio call from the mobile (party A) to a called party B) for which a circuit-switched bearer is selected....The direct access unit 112 then sends an authentication request to the common access server at the selected GGSN, shown in the FIG. 12 example in the form of a password authentication protocol (PAP) or challenge authentication protocol (CHAP) request, to forward the mobile station's authentication parameters including the MSid, Userid, and password to the common access server.... Rather than performing another authentication procedure involving the external ISP, the MSid, Userid, and password received in the PAP/CHAP request are compared to values stored in the common access server during the initial authentication procedure. **If the received values match those stored in the access server, an authentication confirmation is transmitted as a CHAP/PAP response through the direct access unit at the MSC to the mobile station. The common access server matches the provided information with the stored information and authenticates the mobile without having to undertake another authentication procedure with the radius server in the ISP.** This same type of abbreviated authentication procedure is performed for other, subsequent application flows commenced during the session.

Clearly, **this procedure does not suggest "performing automated checking of a right of the terminal to use said subscriber database"** (without admitting that the subscriber database is equivalent to the mobile station information stored at the common access server), but instead suggests (at the most) authenticating a right of the mobile station to initiate the new application

flow (an audio call in the example given by Forslow).

As is made clear in MPEP §2131:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). >"When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02.< "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)."

Clearly, at least the claimed element "performing automated checking of a right of the terminal to use said subscriber database" is not expressly or inherently described by Forslow, and thus the rejection under 35 USC 102(e) should be withdrawn.

Further, the next element of claim 1 recites "automatically transmitting, from the subscriber database, subscriber data to the terminal, the serving network, or the terminal and the serving network, in response to the terminal having the right to use said subscriber database and in response to acceptable authentication of the subscriber database in the bearer network". There is no disclosure of this subject matter in paragraphs [0100]-[0105]. As was noted above, paragraph [0100] discloses that if "the received values match those stored in the access server, an authentication confirmation is transmitted as a CHAP/PAP response through the direct access unit at the MSC to the mobile station." Paragraph [0102] - [0105] variously disclose:

The ISP 130 uses the subnet mask and giaddr to route a response back to the GGSN, which in turn, forwards the response to the mobile station based on the agent remote ID.....The DHCP server 134 in the ISP replies to the Discover message with an Offer message passed on by the GGSN relay agent 120 towards the mobile station including the "offered" configurations that the DHCP server 134 can provide (after checking the incoming and outgoing tunnel identifiers). Multiple offers can be received from various DHCP servers. The mobile station selects the DHCP offer that best satisfies its requirements and sends a DHCP request message to the DHCP server which provided the selected offer. The DHCP server then provides an IP address to the GGSN in a DHCP Acknowledgment message. The IP address is placed in a table along with the mobile's agent remote ID and agent circuit ID/tunnel identifier. The DHCP Acknowledge message is relayed to the mobile host which is configured with a set of selected DHCP parameters including IP address, DNS server name, etc. The common access server in the GGSN also stores these configuration parameters like the IP address allocated to the mobile station along with the authentication parameters like the MSid, Userid, password, etc.....If the mobile station initiates a new application flow over a circuit-switched bearer, i.e., in the example shown in FIG. 13 by sending a PPP Configure-Request via an L2TP tunnel to the GGSN, the common access server compares the PPP Configure Request parameters including an MSid and default configuration parameters with the stored DHCP configuration information and returns an Acknowledgment if the comparison results in a match. Another configuration operation with the ISP DHCP server is not required. After this abbreviated configuration procedure, the common access server simply returns a PPP Configuration Acknowledgment via the direct access unit to the mobile station, and the selected circuit-switched bearer commences transporting the desired information.

It is not seen where the various messages, etc. sent or returned to the mobile station of Forslow disclose "automatically transmitting, from the subscriber database, subscriber data to the terminal, the serving network, or the terminal and the serving network, in response to the terminal having the right to use said subscriber database and in response to acceptable authentication of the subscriber database in the bearer network", where the "subscriber data" is "similar to data stored in the subscriber application comprised by the terminal". Instead, it appears that any mobile station related information stored at the common access server is simply used for making local, faster authentication decisions concerning the mobile station. There is no disclosure that any of this information is transmitted to the mobile station, or elsewhere for that matter.

Clearly, at least this further claimed element not expressly or inherently described by Forslow, and thus the rejection under 35 USC 102(e) should be withdrawn for this reason as well.

In any event, and in order to advance the prosecution of this patent application to an allowance, claim 1 has been amended to incorporate subject matter found in claim 4, which has been cancelled without prejudice or disclaimer.

When rejecting claim 4 the Examiner refers to Forslow at paragraphs [0075] and [0099]-[0105]. The claimed subject matter is not seen to be suggested or disclosed in Forslow. First, and even if one were to assume that the common access server were somehow equivalent to the claimed "subscriber database", which again is not admitted, it is not seen where the mobile station transmits "an address" of the common access server, and thus where there would be any connection established between the mobile station and the common access server based on any such transmitted address.

Further, there is no suggestion or disclosure that any type of IP address of the common access server is transmitted from the mobile station. Paragraphs [0103] and [0104] mention IP addresses, but these appear to be IP addresses for the mobile station, e.g., the "DCHP server then provides an IP address to the GGSN in a DHCP Acknowledgment message. The IP address is placed in a table along with the mobile's agent remote ID and agent circuit ID/tunnel identifier" and "The DHCP Acknowledge message is relayed to the mobile host which is configured with a set of selected DHCP parameters including IP address, DNS server name, etc. The common access server in the GGSN also stores these configuration parameters like the IP address allocated to the mobile station along with the authentication parameters like the MSid, Userid, password, etc."

Claim 1 as now presented for examination recites in part:

where an IP address of said subscriber database is received from the terminal at the serving network and a connection is established from the terminal to said

subscriber database on the basis of the IP address of said subscriber database.

Clearly, claim 1 is not anticipated by Forslow, nor is the claimed subject matter suggested by Forslow. In that claim 1 is clearly allowable over Forslow, then all claims that depend from claim 1 are also allowable for at least this one reason.

The arguments advanced above with respect to claim 1 apply as well to independent claim 13, which has been amended in a similar manner. Claim 16 has been cancelled without prejudice or disclaimer. In that claim 13 is not anticipated by Forslow and is clearly allowable over Forslow, then all claims that depend from claim 13 are also allowable for at least this one reason.

It is noted that the Examiner's references to dependent claims 28 and 30 as being anticipated by Forslow are believed to be erroneous, as these claims depend from claim 25.

Turning now to the continued rejection of claims 25 and 27-33 under 35 USC 103(a) as being unpatentable over Leung in view of Joong, this rejection is also traversed.

The arguments made in the prior response are repeated and incorporated by reference herein.

Leung fails to disclose the currently claimed use of a subscriber application, such as a SIM of a GSM terminal, comprised by the terminal: The cited portions of Leung only disclose the general transmission of a Mobile IP registration request.

As was argued previously, Leung relates simply to IP address assignment in a Mobile IP system. In particular, Leung is directed to assigning an IP address to a mobile node during registration which is accomplished by mapping a mobile node ID (associated with the mobile node) to an assigned IP address. A registration request is sent by the mobile node to a Home Agent. Once an IP address is assigned to the mobile node, the IP address may be transferred to the mobile node in a registration reply composed by the Home Agent.

The use of Joong for purportedly teaching a subscriber database with a functional connection to a bearer network, where subscriber data is similar to data stored in a subscriber application of the terminal, where the subscriber data includes "authentication information" (which is clearly not admitted is the case), does not remedy the deficiencies in the teachings of Leung. As was noted above, the cited disclosure in col. 5 of Joong is simply related to a WAP gateway transmitting a location request to determine a serving mobile switching center MSC 120 and MSC/VLR location area 117 for a wireless client 105.

The Examiner relies several times on col. 7, lines 5-30, of Leung. What is actually stated at col. 6, line 66 to col. 7, line 55 is as follows:

Once the care-of address has been obtained, a registration request is composed and sent via the care-of address at step 208. As described above, the mobile node may have a mobile node ID (e.g., serial number) that identifies the mobile node. In order that the mobile node may be identified by data contained in the registration request, at least a portion of the mobile node ID is obtained and provided in the registration request. Typically, the IP address, or Home Address, of the mobile node is provided in a Home Address field of the registration request. In the absence of an IP address, this field may be used to store the mobile node ID or a portion thereof. Thus, assuming that the mobile node ID contains a number of bytes less than or equal to that of the Home Address field, the mobile node ID may be provided in the Home Address field of the registration request packet. Alternatively, a portion of the mobile node ID may be provided in the Home Address field where the size of the mobile node ID is greater than that of the Home Address field. In order to indicate that the mobile node needs an IP address, the registration request may include an ID indicator that may be used for this purpose. By way of example, the ID indicator may include an ID bit which indicates that the mobile node has an IP address when the ID bit is in a first state, and otherwise indicates that the mobile node does not have an IP address. The ID bit may be one of the reserved bits of the registration request packet.

Once composed, the registration request is sent via the care-of address. If there is a foreign agent, the registration request is sent via the foreign agent care-of address. Alternatively, after the collocated care-of address is obtained at step 206, the registration request is composed and sent via the collocated care-of address.

Once the registration request is sent (via Foreign Agent care-of address or collocated care-of address), it is received by the Home Agent associated with the mobile node at step 210. As described above, the registration request comprises a

registration request packet that includes at least a portion of the mobile node ID. Next, at step 212, it is determined whether the registration is authenticated by the Home Agent, as provided by RFC 2002 for example. Authentication is typically performed using the Home Address field of the registration request. However, as will be described with reference to FIGS. 12-16A, in the case where the size of the mobile node ID is greater than the Home Address field and a portion of the mobile node ID is not guaranteed to be unique, the mobile node ID may be used for authentication purposes. At step 214, if the registration is not authenticated, the mobile node is not registered with the Home Agent and the process is complete as indicated at step 216.

If the registration is authenticated, registration is completed by the Home Agent in steps 218 through 232. The Home Agent verifies if the mobile node needs an IP address at step 218. According to the first embodiment, the Home Agent checks the ID indicator of the registration request to obtain this information. The process flow then diverges at step 220 depending upon whether the mobile node needs an IP address.

The subject matter of claim 25 is not seen to expressly disclosed or suggested, nor is it suggested by col. 11-lines 4-65, col. 12, lines 1-40, or col. 14, lines 7-14.

As regards Joong, it does not teach the above-indicated further features not disclosed by Leung. Furthermore, Joong fails to disclose the claimed subscriber database comprising subscriber data similar to data stored in a subscriber application comprised by the terminal, and subscriber data including authentication information. The cited disclosure in col. 5 is simply related to a WAP gateway transmitting a location request to determine a serving mobile switching center MSC 120 and MSC/VLR location area 117 for a wireless client 105.

As such, even if Leung and Joong were to be combined, which is not admitted is suggested or feasible, the resulting combination would still not teach or suggest the claimed subject matter.

However, in order to advance the prosecution of this patent application towards an allowance, claim 25 has been amended in a similar manner to claims 1 and 13, and now recites in part:

where said terminal device contains an IP address of the subscriber database and transmits the IP address to the serving network, and where a connection is

established from the terminal device to the subscriber database on the basis of the IP address of the subscriber database.

Claim 28 has been cancelled without prejudice or disclaimer.

Support for this amendment is found in the application at, for example, paragraph [0059] of the corresponding US Published Patent Application 2002/0116384 A1:

Further, the IP address of the subscriber database DB is transmitted from the mobile station. The address is preferably stored in the mobile station MS or in the USIM application therein. It may also be fed by the subscriber himself/herself. The address of the subscriber database DB may also be transmitted in the connection set-up message or after the WAP connection has been established to the WAP gateway. A connection from the WAP gateway through the Internet to the subscriber database DB may be established on the basis of the IP address transmitted by the mobile station MS according to the WAP and IP technologies known per se (WAP connection).

No new matter is added.

When rejecting claim 28 the Examiner referred to Leung at col. 7, lines 5-30, col. 11, line 4-65 and col. 12, lines 1-40, and also stated "also see Joong".

The cited portions of Leung have been reviewed. Col. 7, lines 5-30 are reproduced above. Clearly the claimed subject matter is not disclosed. Col. 11, lines 4-65, are similar to col. 7, and deal with "whether a mobile node needs an IP address". Col. 12, lines 1-40, also deal with obtaining an IP address for the mobile node. Joong also discusses IP addresses, such as in col. 2, lines 56-66, but in the context of a WAP gateway that has a table to correlate IP addresses the MSISDN or MIN of wireless clients. Thus, even if these two references were somehow combined, which is not admitted is suggested or technically feasible, the resulting combination would not suggest the claimed subject matter to one skilled in the art.

Clearly, claim 25 as now even further clarified is allowable over the proposed combination of

Leung and Joong. In that claim 25 is clearly allowable, then all claims that depend from claim 25 are allowable for at least this one reason.

The arguments made above apply equally to claim 31. Claim 31 now recites in part "where an IP address of the subscriber database is received from the terminal and is used to establish a connection between the terminal to the subscriber database".

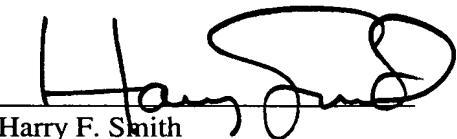
Claim 31 as now even further clarified is also allowable over the proposed combination of Leung and Joong. In that claim 31 is clearly allowable, then all claims that depend from claim 31 are allowable for at least this one reason.

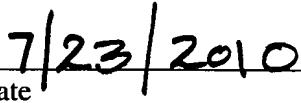
The Examiner is respectfully requested to reconsider and remove the rejections of the claims under 35 U.S.C. 102(e) based on Forslow and under 35 USC 103(a) based on Leung in view of Joong, and to allow all of the pending claims as now presented for examination. An early notification of the allowability of all of the pending claims is earnestly solicited.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

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Respectfully submitted:

  
\_\_\_\_\_  
Harry F. Smith  
Reg. No.: 32,493

  
\_\_\_\_\_  
Date

Customer No.: 29683

HARRINGTON & SMITH, Attorneys At Law, LLC  
4 Research Drive  
Shelton, CT 06484-6212

Telephone: (203)925-9400 ext. 15  
Facsimile: (203)944-0245  
email: hsmith@hspatent.com

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